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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,287	08/19/1999	JOHN G. WOODS	LC-302/PCT/U	4956

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08/12/2003

Loctite Corporation
Legal Department
1001 Trout Brook Crossing
Rocky Hill, CT 06067

EXAMINER

WILSON, DONALD R

ART UNIT

PAPER NUMBER

1713

27

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341,287

Applicant(s)

WOODS ET AL.

Examiner

Donald R Wilson

Art Unit

1713

AS27

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-43 is/are pending in the application.
- 4a) Of the above claim(s) 29,30,32,33 and 38-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28,31,34-37 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 6/11/03, has been fully considered with the following results.
2. The amendment overcomes the rejection of Claims 43 and 44¹ under 35 U.S.C. § 112, first paragraph and the rejection is withdrawn. For the record, it is noted that if the molecular weights of Examples 1 and 2 as measured in Example 10 are in fact number average molecular weights and the molecular weight of the commercial CTBN is in error as alleged by applicant, then based upon the carboxyl numbers of the starting material and the hydroxyl numbers for the hydroxylated product, it follows that the CTBN and HTBN polymers can not have a functionality of two, i.e., on average the CTBN and HTBN polymers would need to be approximately monofunctional. Otherwise it would seem that applicant must also conclude that that both the carboxyl and hydroxyl numbers are also wrong.
3. The rejections of Claim 26 under 35 U.S.C. § 112, second paragraph, and fourth paragraph, are overcome by the amendment and the rejections are withdrawn.
4. The amendment is not deemed to be persuasive in overcoming the prior art rejections which are maintained for reasons discussed below. However, the Examiner withdraws the Admissions by Applicant for the teaching that reactions utilizing ethylene oxide have the disadvantage of ethylene oxide being a gaseous and highly toxic material (instant specification, page 2). Applicant apparently wishes to argue that this is part of their discovery, which the Examiner believes would be hard to sustain, particularly in light of the teachings of Merck Index, Wu and/or Yoshino. However, this Admission by Applicant is dropped because it simplifies the issues, and the teaching is cumulative to the teachings relied upon from Merck Index, Wu and/or Yoshino

Previously Cited Statutes

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

¹ The Examiner acknowledges that the Office Action Summary of the previous Office Action listed claim 42 rather than claim 44 in the rejected claims. However, this is believed to have been an obvious error because claim 42, not claim 44 was listed as a withdrawn claim. Further, from the detailed action it is clear that claim 44 and not claim 42 is rejected.

35 U.S.C. § 103(a) Rejection

6. **Claims 23-28, 31, 34-37 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Merck Index, Wu and/or Yoshino, in further view of Wu or Yoshino.** The basis of this rejection was stated in Detailed Action § 13 of the Office action of 10/3/00, and has been discussed further in Detailed Action § 13 to § 16 of the Office Action of 3/6/01, Additional Comments § 5 to § 8 of the Office action of 5/1/01, and Detailed Actions § 12-16, § 8-12, and §10-15 of the Office Actions of 7/3/01, 2/20/02 and 2/7/03, respectively.

7. **Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Merck Index, Wu and/or² Yoshino, in further view of Wu or Yoshino as applied to claims 23-28, 31, 34-37 and 43-44 above, and further in view of Admissions by Applicant.** The basis of this rejection was stated in Detailed Action § 17-18 of the Office Action of 7/3/01, and has been discussed further in Detailed Action § 10-15 of the Office Action of 2/7/03.

8. Applicant's continued argument that the rejection of claims under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Merck Index, Wu and/or Yoshino, in further view of Wu or Yoshino, is "unclear, confusing and in part meaningless, and thus, improper", as well as the new allegation that the rejection is an "omnibus" rejection cannot be sustained. As pointed out in the previous Office Action, the prosecution history clearly shows that the rejection of is based on four key teachings well known to one of ordinary skill in the art:

- (i) to hydroxyalkylate the same polymers as in the claims with ethylene oxide (Okamoto),
- (ii) that the disadvantages of using ethylene oxide as a hydroxyalkylating agent are well known (collectively or individually, Admissions by Applicant, Merck Index, Wu and Yoshino),
- (iii) that ethylene carbonate is known to be advantageously used as a hydroxyalkylating agent of carboxylic acids in order to overcome known disadvantages of using ethylene oxide (Wu or Yoshino), and

² It is acknowledged that in the previous Office Action "/or" was missing. However, this is believed to have been an obvious "typo" as, (i) the reference is to the rejection "as applied to the claims above", and

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(iv) that the use of a phase transfer catalyst in hydroxyalkylation reactions on carboxylic acids with ethylene carbonate is also well known (Wu or Yoshino).

9. Applicant's invention of a "concurrency requirement" is interesting but is not deemed to be persuasive because it lacks legal standing and is contrary to what is well settled regarding the source of a motivation to combine references.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998).

There appears to be no basis as alleged for each of the references necessarily teaching their combination with the remaining references. Of course if this was required all rejections would be anticipatory rejections. The Examiner believes that one of ordinary skill in the art, confronted with the references relied upon, would have found their combination obvious for reasons of record.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner believes that the stated rejection only takes into account knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure.

11. Applicant's remaining arguments are not deemed to be persuasive for reasons of record.

Action Is Final

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

(ii) the later statement that the references of Admissions by Applicant, Merck Index, Wu and Yoshino are applied "collectively or individually".

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13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

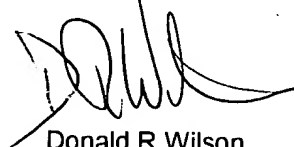
14. This application contains claims 29-30, 32-33 and 38-42 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



Donald R Wilson
Primary Examiner
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